

**Application Serial No. 10/521,192
Docket No. 1093-120 PCT/US
Response to July 11, 2008
Non-Final Office Action**

REMARKS

The Non-Final Office Action mailed July 11, 2008 and the references cited therein have been carefully considered. Claims 1-24 are now pending in the application. Claims 1 and 3 have been amended to clarify that which Applicants regard as the invention. The amendments to Claims 1 and 3 deleted the language objected to by the Examiner in the subject Office Action. Also, by this amendment Claim 20 was made to depend on Claim 18, to maintain proper antecedent basis in claim 20. Additionally, Claim 1 and 21 to more clearly define the transfer film in the claims. Support for these amendments can be found in the specification and drawings, in particular at page 6, lines 29-32 of the specification. Thus, no new matter has been added by these amendments.

Applicant appreciates and acknowledges the Examiner's acceptance of the replacement drawings filed on February 29, 2008 as part of Applicants previous response.

Interview Summary

Applicant respectfully appreciates and acknowledges the telephone interview that took place on November 4, 2008 between the undersigned and Examiner Jamila O. Williams. Prior to the interview, proposed claim amendments were presented. Those proposed claim amendments addressed only the claim rejections under 35 U.S.C. § 112, second paragraph, discussed below. Additionally during the interview, prior art patents 6,808,792 to Weber; 6,213,702 to Wesselink; and 4,533,160 to Malone, were discussed with reference to the pending claims. During the

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interview, the undersigned particularly discussed the fact that the entire transfer film, as taught by Weber is never applied to the base document (as noted in Weber, Col. 7, lines 14-44). Also, the portions of Weber's transfer film that are attached to the document are not attached by the same fixing means that joins any pages of the document. Similarly, neither Wesselink or Malone include a transfer film, which according to the subject specification includes a decorative layer and a releasably secured base film. Thus, in order to clarify the meaning of the term "transfer film" in the claims, applicant hereby amends the claims to incorporate that description. As the currently presented claim amendments were not presented in writing during the interview, no formal agreement was reached with regard to the claims at that time.

Claim Rejections under 35 USC § 112

In the Office Action, Claims 1 and 3 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for reciting such phrases as "book-like" and "paper-like" respectively. Applicants have hereby deleted such phrases and therefore requests that this rejection be withdrawn.

Claim Rejections under 35 USC § 103

Claims 1-4, 6-9, 16-17 and 21 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,808,792 to **Weber** in view of U.S. Patent No. 6,213,702 to **Wesselink**. Additionally, Claim 5 was rejected as being unpatentable under 35 U.S.C. §103(a) over Weber and Wesselink as above, and further in view of U.S. Patent No. 5,103,583 to

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VanErmens. Further, Claims 10-15, 18-20 and 22-24 have been rejected as being unpatentable under 35 U.S.C. §103(a) over Weber and Wesselink as above, and further in view of U.S. Patent No. 4,533,160 to **Malone**.

The claim rejections presented in the subject Office Action are substantially similar to those presented in the previous Office Action mailed October 30, 2007, with the Wesselink patent substituted in place of the previously cited Vermeulen patent. Applicant respectfully traverses these rejections for the same reasons set forth in the previous Response dated February 29, 2008.

More specifically, **Weber** discloses a specific type of transfer foil which has a carrier foil 1, a base film 3 and a hot stamping foil 6 laminated together by adhesive layers 2 and 4 (Fig.1). Weber discloses how to transfer the transfer layers of this transfer foil to a substrate 8, which is a document (see Fig. 2). However, Weber does not disclose or suggest incorporating, securing or binding a transfer foil into a multi-page document, such as a passport or other security document. While Weber suggests that a transfer foil can be used to apply a decorative layer to a multi-page document, such as a passport, it does not teach or suggest fixing the transfer foil itself to the document. Once the decorative layer of Weber is adhered to the substrate, the release layer previously holding the base film and the decorative layer together, softens so that the base film is easily removed (See Weber Col. 7, lines 25-31). Thus, in Weber while the decorative layer gets secured to the document, the transfer film (including both a base film and a decorative layer) is never secured thereto. Furthermore, Weber certainly does not disclose or suggest fixing the

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transfer foil to the security document using the same means of fixing or adhesive securing the multiple pages of the document. Accordingly, Weber fails to teach or reasonably suggest all the elements of the claimed invention.

Wesselink teaches a method of manufacturing or assembling a booklet. In order to secure multiple pages of the booklet, Wesselink uses a band in combination with a plate assembly. Initially, it should be noted that Wesselink does not teach or reasonably suggest the use of a transfer film. While in Wesselink strip 2 is attached to a laminate member 1, as shown in Fig. 2, these elements are not a transfer film that includes a decorative layer and a releasably secured base film. Accordingly, Wesselink also does not teach or reasonably suggest incorporating into a security document a transfer film that includes both a decorative layer and base film as claimed. Further, there is no teaching or reason to replace the laminate member 1, taught by Wesselink with a transfer film that includes a removeably secured base film. Accordingly, Wesselink also fails to teach or reasonably suggest all the elements of the claimed invention.

Additionally, neither VanErmel and Malone teach or suggest the missing elements discussed above with regard to Weber or Wesselink. In particular, neither VanErmel or Malone teach or reasonably suggest incorporating a transfer film, as claimed, into a multi-page document by the same means of fixing or adhesive that joins the pages of the document. Accordingly, both VanErmel and Malone individually or in combination fail to teach or reasonably suggest all the elements of the claimed invention.

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Consequently, a person of ordinary skill in the art combining the teachings of Weber, Wesselink, VanErmel or Malone would not arrive at the present invention as recited in the claims, and particularly independent claims 1 and 21. While a skilled artisan might use the teaching of Weber to apply a decorative element to a booklet as taught by Wesselink, there is no teaching, reason or motivation to actually bind the entire transfer film, base and all, to the booklet. Thus, one would not bind the transfer film to the booklet, let alone actually use the same fixing or adhesive that binds the booklet to bind the transfer film.

Applicant submits that the amended claims, particularly independent claims 1 and 21, are clearly distinguishable from the cited prior art references. Also, claims 2-20 and claims 22-24, which ultimately depend from Claims 1 and 21, respectively, are similarly patentable over the art of record by virtue of their dependence. Also, Applicant submits that Claims 2-20 and claims 22-24 define patentable subject matter in their own right. In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and allowance of the claims presented. Accordingly, Applicant hereby respectfully requests reconsideration and withdrawal of the current rejections of the claims under 35 U.S.C. §103(a) as being unpatentable over Weber, Wesselink, VanErmel or Malone, alone or in combination.

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If the Examiner has any questions or suggestions to expedite allowance of this application, she is cordially invited to contact Applicant's attorney at the telephone number provided.

Respectfully submitted,

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